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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,867

05/11/2007

Stephen Daryl Barnes

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EXAMINER

TILLERY, RASHAWN N

ART UNIT

PAPER NUMBER

2174

MAIL DATE

DELIVERY MODE

09/11/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,867	Applicant(s) BARNES, STEPHEN DARYL	
	Examiner RASHAWN TILLERY	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed 6/8/2009.
2. Claims 1-8 and 10-17 are pending in this application. Claims 1, 5, 10 and 14 are independent claims. In the instant Amendment, claims 1, 3, 5 and 7 were amended, claim 9 was canceled and claims 10-17 were added. This is a Non-Final action on the RCE filed 7/2/2009.

Claim Objections

3. Claims 10 and 14 are objected to because of the following informalities: the term "and" is recited in step "(i)" of the claims; the term should be replaced with "or" to be consistent with the specification. Appropriate correction is required.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 10 and 14 recite "a computer-readable medium;" the claims lack antecedent basis for this limitation.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5, 10 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Each of the claims recites “a single one of said buttons **automatically** enables all of the following to be performed.”

Nowhere in Applicant's specification is it disclosed that a mail item is **automatically** removed from the inbox. For instance, Applicant's specification discloses that user is given the option to delete a mail item upon applying one of four actions- "Deal With It Now," "Decide What To Do With It," "Delegate It," and "Delete It (see page 3, lines 13-33)". Applicant's specification further discloses that upon selection of a mail item in an inbox, "the user would then be prompted to determine what action 11 to take regarding the original mail item. The user would be able to select 12 whether to Ditch the original mail item and thus delete 13 the original mail item, to mark the mail as done and thereby move 14 the original mail item to the done folder, or to skip this step and simply return 15 the user to the inbox (see page 5, lines 20-29 and page 6, lines 6-9; also see Figs 2, 3, 5, 6, 9, 11, 13, 15 and 17)."

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1 and 5 are rejected under 35 U.S.C. 101 for failing to fall within a proper statutory category of invention. The system of claims can be merely a software system which is non-statutory. The system must include some hardware element.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Pang (US 6493007).

Regarding claim 1, Pang discloses a COMM Addin for personal organizational software, said COMM Addin adding a plurality of menu buttons to at least one personal organizational software page viewable on a user's screen, said menu buttons operable by said user, such that when said user receives a mail item in said user's inbox operation of a single one of said buttons automatically enables all of the following to be performed (see col. 7, lines 2-19 where the graphical user interface for an e-mail system is discussed; also see figs 3-5):

(i) said user to reply to the mail item, forward the mail item, or create a new item entry (see col. 6, lines 1-6 and col. 8, lines 4-15 where it is discussed that user can reply to an e-mail or forward an e-mail);

(ii) said mail item is respectively copied to said reply, forwarded message or new item entry (see col. 6, lines 27-39 and col. 9, lines 3-13 where it is discussed that a copy of a reply e-mail is maintained in a log); and

(iii) said mail item is removed from said inbox (see col. 6, lines 20-26 and col. 7, lines 42-56 where it is discussed that an e-mail is deleted after user replies).

Regarding claim 2, Pang discloses said new item includes a calendar entry, a note, a task, a project or a contact (see fig 3, 311, 317 and 319).

Regarding claim 3, Pang discloses said buttons are operable from a home page of said personal organizational software (see fig 3, 300).

Regarding claim 4, Pang discloses said button further automatically re-labels said reply, forwarded message or new item entry (see col. 6, lines 27-39 where it is discussed that a copy of a reply e-mail is maintained in a log).

Claims 5-8 are similar in scope to claims 1-4, respectively, and are therefore rejected under similar rationale.

Claims 10-13 are similar in scope to claims 1-4, respectively, and are therefore rejected under similar rationale.

Claims 14-17 are similar in scope to claims 1-4, respectively, and are therefore rejected under similar rationale.

Response to Arguments

11. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to RASHAWN TILLERY whose telephone number is 571-272-6480. The examiner can normally be reached on M-F 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/RASHAWN TILLERY/
Examiner, Art Unit 2174

/Adam L Basehoar/
Primary Examiner, Art Unit 2178